



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Deadwyler, et al.
U.S. APPLICATION NO. : 10/541,687
FILING DATE : November 21, 2005
TITLE : Method of Treating Cognitive Decline Due to Sleep
Deprivation and Stress
GROUP ART UNIT : 1617
EXAMINER : Jennifer M. Kim

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Restriction Requirement

In response to the Examiner's office action dated March 18, 2009, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally *elect with traverse* to prosecute the invention of group V, consisting of claims 2-3, drawn to a method for treating or preventing cognitive impairment comprising administering an AMPA receptor potentiator having a compound of structure set forth in claim 2, classified in class 514, subclass 385. Further, Applicants provisionally *elect with traverse* to prosecute a single selection species wherein said potentiator is 1-(benzofurazan-5-ylcarbonyl)morpholine (BCM) of claim 3. Claims 1, 2-3 and 14-19 are readable on the elected species of invention group V. Notwithstanding Applicants' election, Applicants respectfully request the Examiner, in the interest of administrative efficiency, to at least also consider the examination of a slightly broader sub-genus wherein the method also embraces the compounds which are grouped in invention group VII, corresponding to claims 6-12. Claims 1-3, 6-12 and 14-19 are readable on the proposed sub-genus which corresponds to invention groups V and VII. Invention groups V and VII are closely related, although patentably distinguishable and as explained hereinbelow as respectfully submitted, the examination of the subgenus comprising these two invention groups (V and VII) would comply with the requirements of the MPEP and foster significant administrative efficiency, a would-be strong policy goal of government agencies in these trying economic times.

Notwithstanding the request for Applicants' species election, Applicant's election of the proposed species as set forth above, *and* Applicants' proposed sub-genus also set forth above, in the alternative, at the request of Applicants, and in the further interest of an efficient examination of all of the claims of the original application, Applicants respectfully request the Examiner to give serious consideration to examining all of the claims of the instant application, namely claims 1-33 and 35 (note that a duplicate claim 3 was cancelled in the preliminary amendment filed with the original national phase application) together without restriction for purposes of expediting prosecution of the present application. Although the invention of the various species and invention groups as detailed by the Examiner are considered patentably distinct, it is respectfully submitted that the inventions are sufficiently closely related that they may be examined together with a significant degree of administrative efficiency.

Notwithstanding Applicants' election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request the Examiner reconsider her restriction requirement *in its entirety*. Applicants respectfully submit that prosecution of all of the originally filed claims should not be restricted to the elected invention, for the reasons which are provided below.

According to MPEP §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of all of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct inventions. Moreover, a search has already been conducted in the present application. See the previously filed international search report.

Although the claimed invention (species) groups are generally patentably distinct from each other, Applicants respectfully submit that any search the Examiner would need to conduct in examining the instant application and the examination itself would not be unduly burdensome. Moreover, an international search report has been presented in the application and was performed with respect to all of the original claimed subject matter. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the

Examiner as to require restriction, especially in light of the previously presented international search report.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here, but rather weight in favor of examining all of the originally filed claims. In general, in determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention without filing further divisional applications, which add considerable costs to the process. This is particularly true where, as here, the search burden for the Examiner is already reduced by the presentation of the international search report in the present application.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in MPEP § 803. However, in the alternative, Applicants respectfully request that the Examiner at least carefully consider prosecuting the sub-genus identified in the first paragraph of this response, inasmuch as the sub-genus comprises species which are related, although patentably distinguishable. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement in its entirety or at least allow the examination of the limited sub-genus identified above.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way. No fee is due for the presentation of this response. If any additional fee is due or any overpayment has been made, please debit or credit Deposit Account 04-0838.

Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

By: 

Henry D. Coleman

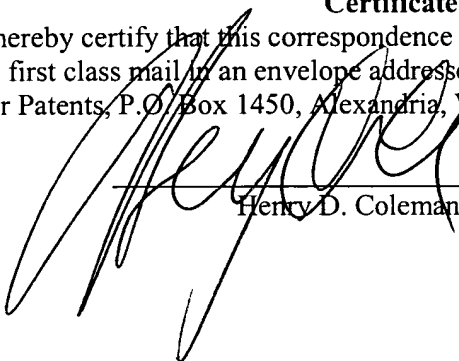
Reg. No. 32,559

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on June 18, 2009.


Henry D. Coleman (Reg. No. 32,559)